

Remarks

Applicants have amended claim 33 to better define the claimed invention. Applicants respectfully submit that no new prohibited matter has been introduced by this Amendment. The Office Action dated May 16, 2002 (Paper No. 18) has been carefully reviewed and the forgoing remarks are made in response thereto. The Examiner's courtesy in discussing the priority claim in the present application with Applicants' agent on August 8, 2002 is acknowledged with appreciation. Applicants appreciate the Examiner's efforts in furthering the prosecution of this Application. In view of the above claim amendments and following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Summary of the Office Action

1. The request for a continued prosecution application was granted and the declaration by Matthew Gonda and amendment filed on April 15, 2002 were entered.
2. Claims 32-42 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-9 of U.S. Patent 5,905,027.
3. Claim 33 was rejected under 35 U.S.C. 112 (first paragraph) as containing subject matter which was not described in such a way as to enable the skilled artisan to use the invention.
4. Claims 32-49 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent 5,905,027 or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 5,905,027.
5. Claims 32-35 and 37-44 were rejected under 35 U.S.C. 102(b) as being anticipated by Sontheimer *et al.* (1997).
6. Claims 32-38 and 40-49 were rejected under 35 U.S.C. 102(a) as being anticipated by Soroceanu *et al.* (1998) Cancer Research 58, 4871-4879.

Rejection based on obviousness-type double patenting

Claims 32-42 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 3-9 of U.S. Patent 5,905,027. Applicants respectfully request that this rejection be held in abeyance until such time that the Examiner considers the pending claims to be free of the prior art.

Rejection based on 35 U.S.C. 112 (first paragraph)

Claim 33 was rejected under 35 U.S.C. 112 (first paragraph) as containing subject matter which was not described in such a way as to enable the skilled artisan to use the invention. The Office Action purports that the specification does not reasonably provide enablement for the skilled artisan to detect a peripheral primitive neuroectodermal tumor (PPNET) in a tissue sample using chlorotoxin. For the sole purpose of expediting prosecution, Applicants have amended claim 33, without prejudice or disclaimer, to remove PPNET from the claim language. In view of the amendment, Applicants submit that the rejection is moot and request that it be withdrawn. ✓

Rejection based on 35 U.S.C. 102(e) or 103(a)

Claims 32-49 were rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent 5,905,027 or in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Patent 5,905,027. As mentioned above, Applicants appreciate the Examiner's courtesy in discussing the priority claim in the present application with Applicants' agent. Applicants acknowledge the Examiner's concession in that discussion to disregard any rejection where U.S. Patent 5,905,027 is cited as prior art because the present application claims priority to U.S. Application 08/774,154 (now U.S. Patent 5,905,027). Applicants also acknowledge the Examiner's concession in that discussion that U.S. Patent 5,905,027 is not available as prior art because of Applicants' priority claim. Applicants therefore request that any rejection citing U.S. Patent 5,905,027 as prior art be formally withdrawn in writing. ✓

Rejection based on 35 U.S.C. 102(b)

Claims 32-35 and 37-44 were rejected under 35 U.S.C. 102(b) as being anticipated by Sontheimer *et al.* (1997). Applicants bring to the Examiner's attention that the full citation for this reference was not provided on the accompanying form PTO-892. The Office Action refers to (N) on form PTO-892 (see Office Action at page 8, line 5), however, no reference is cited on this line in Applicants' copy of form PTO-892. Applicants assume, however, that based on citation to the pages in this reference (see Office Action at page 9, line 2) and the citation of this reference as a foreign patent document, that the Office Action is referring to WO 97/24619 (published on July 10, 1997). Yes

Applicants bring to the attention of the Examiner that WO 97/24619 corresponds to U.S. Application 08/774,154 (now U.S. Patent 5,905,027) and that the disclosure of WO 97/24619 is identical to U.S. Patent 5,905,027. Furthermore, both the present application and WO 97/24619 claim priority

back to U.S. Provisional Application 60/009,293. Applicants also note that WO 97/24619 has an international publication date (July 10, 1997) that is after the filing date of U.S. Application 08/774,154 (December 26, 1996), to which the present application claims priority. Applicants therefore submit that WO 97/24619 is not available as prior art against the present application because of the identical disclosure of this publication in Applicants' priority application (U.S. Application 08/774,154), the filing date of which pre-dates the international publication date of the cited reference. In view of the above remarks, Applicants respectfully request that the rejection be withdrawn.

Rejection based on 35 U.S.C. 102(a)

Claims 32-38 and 40-49 were rejected under 35 U.S.C. 102(a) as being anticipated by Soroceanu *et al.* (1998) Cancer Research 58, 4871-4879. The Office Action purports that Soroceanu *et al.* discloses preparation of biotinylated chlorotoxin or fluorescent-tagged chlorotoxin for the detection of chlorotoxin binding to glioma cells *in vitro* or *in vivo*. Applicants bring to the attention of the Examiner that the cited reference reports the experimental data disclosed in U.S. Application 08/774,154, filed December 26, 1996, of which, the instant application is a CIP. Applicants therefore submit that Soroceanu *et al.* is not available as prior art because this application claims a priority date earlier than the publication date for the cited reference. In view of the above remarks, Applicants respectfully request that the rejection be withdrawn.

Conclusion

The foregoing remarks are being made to place the application in condition for allowance. Applicants respectfully request reconsideration and the timely allowance of the pending claims. A favorable action is awaited. Should the Examiner find that an interview would be helpful to further prosecution of this application, he is invited to telephone the undersigned at his convenience. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with Markings to Show Changes Made" as required.

Except for issue fees payable under 37 C.F.R. 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **Constructive Petition for Extension of Time** in accordance with 37 C.F.R. 1.136(a)(3).

Dated: **August 15, 2002**
Morgan, Lewis & Bockius LLP
Customer No. **09629**
1111 Pennsylvania Avenue, N.W.
Washington, D.C. 20004
202-739-5870

Respectfully submitted
Morgan, Lewis & Bockius LLP

Michael S. Tuscan
Michael S. Tuscan
Registration No. 43,210